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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,884	09/27/2000	Juan A.Morales Tirado	D/A0571	7382

7590

03/13/2002

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EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/670,884

Applicant(s)

TIRADO ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-23 is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, 22, and 23, drawn to classifier wheel, classified in class 209, subclass 714.
- II. Claims 19-21, drawn to a process for separating particulates, classified in class 209, subclass 154.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of claim 19 does not require a disk or a fastener. The apparatus of claim 1 does not require the method step of rotating a classifier wheel.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The claims stand objected to under 37 CFR 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim.

A claim is controlled by its preamble. A dependent claim must always fall within the scope of the preamble of its parent claim. Claims 10, 16, and 19 are considered dependent by the Office on claims 1, 10, and 16, respectively, for drawing on those parent claims by direct incorporation. When one claim invokes another claim, it is dependent upon that claim. The Applicant does not get charged for these dependent claims, or if so, gets charged much less than the filing of an independent claim. When a claim has a different preamble than another claim, it is considered distinct from said other claim, and is treated on different grounds, earning its own search and, further, a completely independent right of examination, independent from the examination of other independent claims.

The manner in which the claims appear invites the ultimatum as follows:

Either;

a) the claims must be put in independent form so that the Office can charge the applicant the proper fees for multiple independent claims more than 2, and only then establish a search and/or impose further restriction, or

b) the claims can be left as they appear, and the Examiner will refuse to examine all subject matter with a scope beyond that of claim 1 as intended use, discarding their significance and rejecting them out of hand.

This Application will not be Examined on the merits until it is placed in proper dependency, wherein all dependent claims further limit the scope of an independent claim in a clear and concise manner.

Additional burdens are placed upon the Office in the event that a rejection would be made on a dependent claim, while the independent claim stands patentable. New preambles incite new examination, and it is clearly possible that claim 16 could be considered rejectable under art while claim 10 would not. Therefore, a discrepancy is found which has the potential to completely confound all common Examination process, removing from the Examiner and the Applicant a proper avenue for prosecution in which allowability can be determined, a finite search can be performed, and proper fees can be calculated.

Additional burdens are placed upon the Office in that a search for a disk with a hole in it would rarely if ever produce art disclosing a classifier wheel, much less a

process for classifying. In searching for anticipatory references, the Examiner is bound to the scope of the preamble, and therefore has no way to meaningfully retrieve and apply references while each dependent claim crawls further and further outside the scope of the search criteria.

Examination on the merits will gladly be performed when these claims are placed in a non-objectionable format.

Again, the most significant reason this objection cannot be overlooked is the possibility that art would be applicable to a dependent claim, while not being applicable to its parent claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

Application/Control Number: 09/670,884
Art Unit: 3653

Page 6

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March 11, 2002


DONALD R. WALSH
SUPERVISORY PATENT EXAMINER
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